

REMARKS

No claims are being added, canceled or amended. Thus, a listing of the claims is not necessary.

Applicants respectfully request the Examiner to reconsider the present application in view of the following. Applicants' previous remarks are rendered moot in view of the new grounds of rejections (see page 4 of the outstanding Office Action).

Status of the Claims

Claims 1-7, 9-17, 41 and 42 are pending in the present application.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues Under 35 U.S.C. § 102(b) and § 103(a)

Claims 1-4, 6, 9, 41 and 42 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bjursten *et al.* (U.S. Patent No. 5,152,993; newly cited).

Also, claims 5, 7 and 10-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bjursten '993.

These rejections are respectfully traversed, and reconsideration and withdrawal thereof are respectfully requested. Overall, Applicants respectfully submit that the cited Bjursten '993 reference fails to disclose all claimed features.

Bjursten '993 describes a method for preparing an implant body comprising bringing the implant body into contact with a hydrogen peroxide solution for a limited period of time (see column 2, starting at line 6). Further, the implant has a surface layer of hydrated oxide with peroxide and superoxide incorporated in a polymeric structure, which is in the form of a gel-like coating (see column 2, lines 18-22). In addition, the surface layer in Bjursten '993 is said to decompose by chemical reduction to hydrogen peroxide and titanium hydroxide, and the gel thus acts as a slow release hydrogen peroxide reservoir (see column 2, lines 26-29) (Applicants' emphasis added). The Bjursten '993 reference also discloses that biomolecules can be incorporated in the surface layer (see column 2, lines 56-57) via covalent binding (column 3, line 2). Thus, one of ordinary skill in the art understands that the main object of the Bjursten implant surface that is treated with H₂O₂ is to function as a slow-release hydrogen peroxide reservoir (column 2, lines 28-29). Additionally, the hydrogen peroxide in Bjursten '993 is described as having an inhibiting effect on the inflammatory activity due to implantation, thus improving the healing time of the implant (column 2, lines 30-31; see also the Abstract).

In the outstanding Office Action, the Examiner states that Bjursten '993 describes a prosthetic device comprising a metal material (with reference to titanium), wherein the metal material comprises a layer of a corresponding hydroxide material consisting of titanium hydroxide, "wherein the layer of hydroxide material comprises one or more biomolecule substances associated therewith" (see the bottom paragraph of page 2 of the Office Action). However, given the description in Bjursten '993, this reference still fails to disclose all instantly claimed features. The present invention relates to an implant comprising a metal material, such as titanium, wherein

surface parts of the metal material comprises a layer of a corresponding hydride material (see, e.g., the Markush group of pending claim 1), and the layer further having an ampholytic biomolecule substance. Bjursten '993 does not describe an implant as instantly claimed, including an implant comprising a layer of hydride material. Therefore, these rejections have been overcome.

Regarding the § 102(b) rejection, “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus, because of the lack of disclosure of all features as instantly claimed, the rejection in view of Bjursten '993 is overcome. Reconsideration and withdrawal of this anticipatory rejection are respectfully requested.

Regarding the § 103(a) rejection, a *prima facie* case of obviousness requires disclosure of all claimed features. See *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d (BNA) 1438, 1442 (Fed. Cir. 1991); see also *In re Kotzab*, 55 U.S.P.Q.2d (BNA) 1313, 1316-17 (Fed. Cir. 2000). Thus, this rejection has been overcome as well since there is no disclosure of all claimed features in the Bjursten '993 reference. Applicants add that the requisite motivation and reasonable expectation of success are lacking as well when the teaching or suggestion to make the claimed modification/combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). That is not the case here given the Bjursten '993 disclosure. Accordingly, reconsideration and withdrawal of this obviousness rejection are respectfully requested.

Application No. 10/010,140
Art Unit 3738
Reply to Office Action of March 6, 2006

Docket No.: 0104-0527PUS1

Acknowledgement of Supplemental Amendment

Applicants respectfully request acknowledgement of receipt of Applicants' Supplemental Amendment filed on December 27, 2005. The outstanding Office Action indicates it is in response to Applicants' communication of January 4, 2006. Minor amendments to the claims were made in the December 27 Supplemental Amendment.

Conclusion

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact Eugene T. Perez (Reg. No. 48,501) at the offices of Birch, Stewart, Kolasch & Birch, LLP.

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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